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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,968	10/01/2003	Katsuhisa Ogawa	1232-5170	9275
27123	7590	07/29/2008	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			CLOUD, JOIYA M	
			ART UNIT	PAPER NUMBER
			2144	
			NOTIFICATION DATE	DELIVERY MODE
			07/29/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOPatentCommunications@Morganfinnegan.com  
Shopkins@Morganfinnegan.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/677,968	<b>Applicant(s)</b> OGAWA, KATSUHISA	
	<b>Examiner</b> Joiya M. Cloud	<b>Art Unit</b> 2144	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/01/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***DETAILED ACTION***

1. This action is responsive to the communication filed 04/28/2008. Claims 16-20 represent Method and apparatus for judging coincidence of addresses, and service provision method and service provision apparatus. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/28/2008 has been entered.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 16-20**, are rejected under 35 U.S.C. 102(b) as being anticipated by Mersky (US Publication No. 2003/0037012 A1).

As per **claim 16**, Mersky teaches a service provision method of providing, via the Internet, a service to an apparatus to which a first network and a second network are connected, comprising: a first acquisition step of acquiring a host address of the apparatus, as connected to the first network (**Figure 1 and paragraph [0028], lines 15-21, where the agent system accessing the network via an ISP and initiates a connection to a transaction system using the acquired host address**), before the apparatus is connected to the second network (**merchant system**); a second acquisition step of acquiring owner information of the apparatus (**paragraph [0028], lines 21-25**); a third acquisition step of acquiring a network address of the second network in accordance with the owner information acquired at the second acquisition step from a database storing the network address of the second network and the owner information of the apparatus (**paragraph [0030], where the definition tables stores the merchants (owner information) and corresponding network addresses**); a fourth acquisition step of acquiring, when a signal is transmitted from the apparatus via the second network, a host address and a network address of a sending side included in the signal (**paragraph [0029]**); and a provision step of providing the service, via the Internet (**paragraph [0030]**), to the apparatus via the second network in the case in which the host address acquired in said first acquisition step and the network address acquired in said third acquisition step coincide with the host address and the network address acquired in said fourth acquisition step (**paragraph [0031]**).

As per **claim 17**, Mersky teaches a method wherein, in said first acquisition step, a host address of an apparatus connected to a first network in an apparatus factory is acquired (**Figure 1**).

**As per claims 18 and 19**, Mersky teaches a method wherein, in said second acquisition step, a part of the network address of the second network is acquired from an Internet service provider for connecting the second network to the Internet and wherein, in said second acquisition step, a part of the network address of the second network is acquired from a DNS server **(paragraph [0030], lines 11-24)**.

**As per claim 20**, claim 20 is substantially the same as claim 16 and list similar limitations, but in apparatus form rather than method form. Therefore, the rejection for claim 16 applies equally as well to claim 20.

### ***CONCLUSION***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joiya Cloud whose telephone number is 571-270-1146. The examiner can normally be reached Monday to Friday from on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3922.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information

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for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

***JMC***

**/William C. Vaughn, Jr./**

**Supervisory Patent Examiner**

**July 11, 2008**